

REMARKS

In the Office Action, the Examiner withdrew claims 2, 5, 8-14, 20, 32, 38-44, 50, 62, 63, 68-74, 80, 92, 97-103, 109, 121, 127-133, 139, 151, 157-163, 169, 181, 187-193, 199, 211, 217-223, 229, 240-263, 265-292, and 294-297 from further consideration as being directed to non-elected claims. Claims 1, 3, 4, 6, 7, 15-19, 21-31, 33-37, 45-49, 51-61, 64-67, 75-79, 81-91, 93-96, 104-108, 110-120, 122-126, 134-138, 140-150, 152-156, 164-168,¹ 170-180, 182-186, 194-198, 200-210, 212-216, 224-228, 230-239, 264, and 293 have been examined on the merits.

I. Claim Objections

In the Office Action, claims 19, 21, 49, 79, 108, 150, 198, and 228 were objected to based on allegations that claims 21 and 150 “duplicate[]” claims 15 and 120, respectively, and that claims 19, 49, 79, 108, 198, and 228 “are not [] in a complete sentence” Office Action at 2. Applicant respectfully traverses each of these objections because 1) claims 21 and 150 differ in scope from claims 15 and 120, respectively, and 2) each of claims 19, 49, 79, 108, 198, and 228 are in complete sentence form and comply fully with U.S. patent statutes and U.S. Patent and Trademark Office rules of practice relating to the proper form of claims.

In particular, claim 15 recites “[t]he brush of claim 1, wherein the core is located off-center in the cross-section of the brush over at least a portion of the length of the brush.” In contrast, claim 21 recites “[t]he brush of claim 1, wherein the core passes

¹ The Office Action Summary indicates that claims 167 and 168 have been withdrawn from consideration (see page 2), but the Office Action includes a rejection of claims 167 and 168, so the Examiner has apparently examined claims 167 and 168 on the merits.

through a point other than the center of the cross-section of the brush at at least one location along the length of the core.” Thus, the scope of these claims is not necessarily the same. Therefore, claims 15 and 21 are not “duplicate[]” claims with respect to one another, and Applicant respectfully requests reconsideration and withdrawal of the objection to these claims.

Concerning claims 120 and 150, claim 120 recites, in pertinent part, “wherein the envelope surface on the convex side of the curve defines a substantially planar surface along at least a portion of the length of the brush, the substantially planar surface intersecting the plane of curvature.” In contrast, claim 150 recites, in pertinent part, “wherein, in the plane of curvature, the envelope surface on the convex side of the curve defines a substantially rectilinear edge along at least a portion of the length of the brush.” Thus, the scope of these claim is not necessarily the same. Therefore, claims 120 and 150 are not “duplicate[]” claims with respect to one another, and Applicant respectfully requests reconsideration and withdrawal of the objection to these claims.

Concerning claims 19, 49, 79, 108, 198, and 228, Applicant does not understand the nature of this objection. Applicant respectfully submits, however, that each of these claims is in complete sentence form and complies fully with U.S. patent statutes and U.S. Patent and Trademark Office rules of practice relating to the proper form of claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the objection to claims 19, 49, 79, 108, 198, and 228. If the Examiner continues to believe that any of these claims are in improper form, the Examiner is cordially invited to contact Applicant's undersigned attorney to discuss this issue in more detail.

II. Claim Rejection under 35 U.S.C. § 102(e) based on Vasas

In the Office Action, claims 1, 15-19, 21-24, 26-31, 45-49, 51-54, 56-60, 210, 233, 235-238, 264, and 293 were rejected under 35 U.S.C. § 102(e) based on Vasas (U.S. Patent No. 6,237,609). Claims 1, 31, and 210 are the only independent claims rejected under § 102(e) based on Vasas. Applicant respectfully traverses the rejection of each of those claims under § 102(e) based on Vasas because Vasas fails to disclose all of the subject matter recited in each of those claims. See M.P.E.P. § 2131.

A. Independent Claim 1

Applicant's independent claim 1 recites a brush, including among other recitations, "a core curved along at least a portion of its length so that an axis of the core defines a curve . . . ; and . . . bristles defining a cross-section of the brush . . . , wherein the core passes through the center of the cross-section of the brush at at least one location along the length of the core." The Vasas reference does not disclose or suggest at least that subject matter recited in Applicant's independent claim 1.

In the Office Action, the rejection statement interprets the Vasas reference as disclosing, among other things, a mascara brush comprising a core, "wherein the core passes through the center of the cross-section [fig. 2] [sic] of the brush at at least one location along the length of the core." Office Action at 4. Applicant respectfully disagrees with the rejection statement's interpretation of Vasas. Although the Vasas reference might possibly be alleged as disclosing a core extending through a vertical plane P in Fig. 2, Vasas does not disclose the core passing through the center of a

brush cross-section located in a plane perpendicular to the vertical plane P. For at least this reason, the Vasas core does not “pass[] through the center of the cross-section of the brush at at least one location along the length of the core,” as recited in Applicant’s independent claim 1. For at least this reason, Applicant’s independent claim 1 is patentably distinguishable from Vasas.

B. Independent Claim 31

Applicant’s independent claim 31 recites a brush, including, among other recitations, “a core curved . . . so that an axis of the core defines a curve in a plane of curvature, the curve having a convex side and a concave side; and a plurality of bristles . . . comprising ends defining an envelope surface of the brush . . . , [] wherein, in the plane of curvature, the distance from the convex side of the curve to the envelope surface varies along at least a portion of the length of the core.” The Vasas reference does not disclose at least that subject matter recited in Applicant’s independent claim 31. In particular, the Vasas reference does not disclose or suggest all of the above-recited subject matter of independent claim 31 at least because Vasas discloses a brush, wherein the distance from a convex side of the curve of the envelope surface does not vary along at least a portion of the length of the core. (See, e.g., Vasas Fig. 3.) For at least this reason, Applicant’s independent claim 31 is patentably distinguishable from Vasas.

Applicant respectfully notes that the rejection statement does not provide any explanation concerning how the Vasas reference might possibly be alleged to disclose the above-recited subject matter of independent claim 31. Therefore, if after

considering Applicant's comments about why independent claim 31 is patentably distinguishable from Vasas, the Examiner refuses to withdraw the rejection of independent claim 31 under § 102(e) based on Vasas, Applicant respectfully requests that the Examiner provide a complete explanation about how Vasas allegedly discloses all of the subject matter recited in independent claim 31. Further, Applicant respectfully requests that any Office Action including such a rejection be made non-final, so that Applicant will be provided with a fair opportunity to respond to such rejection.

C. Independent Claim 210

Applicant's independent claim 210 recites a brush, including, among other recitations, "a core curved . . . so that an axis of the core defines a curve in a plane of curvature; and a plurality of bristles . . . defining a cross-section of the brush . . . , [] wherein along at least a portion of the length of the brush, the cross-section of the brush has a varying width dimension, the width dimension passing through the core and being perpendicular to the plane of curvature." Vasas does not disclose at least this subject matter recited in independent claim 210 at least because Vasas discloses a brush having a cross-section with a constant width dimension passing through the core and perpendicular to the plane of curvature. (See, e.g., Vasas Figs. 2, 5, 9, and 10.) For at least this reason, Applicant's independent claim 210 is patentably distinguishable from Vasas.

Applicant respectfully notes that the rejection statement does not provide any explanation concerning how the Vasas reference might possibly be alleged to disclose the above-recited subject matter of independent claim 210. Therefore, if after

considering Applicant's comments about why independent claim 210 is patentably distinguishable from Vasas, the Examiner refuses to withdraw the rejection of independent claim 210 under § 102(e) based on Vasas. Applicant respectfully requests that the Examiner provide a complete explanation about how Vasas allegedly discloses all of the subject matter recited in independent claim 210. Further, Applicant respectfully requests that any Office Action including such rejection be made non-final, so that Applicant will be provided with a fair opportunity to respond to such rejection.

III. Claim Rejection under § 103(a) based on Gueret in Combination with Vasas

In the Office Action, claims 1, 3, 4, 6, 7, 31, 33-37, 61, 64-67, 75-79, 81-89, 91, 93-96, 104-108, 110-120, 122-126, 134-138, 140-149, 150, 152-156, 164-168, 170-179, 210, 212-216, 224-228, 230-233, and 235-239 were rejected under 35 U.S.C. § 103(a) based on Gueret (U.S. Patent No. 5,853,011) in combination with Vasas. Claims 1, 31, 61, 91, 120, 150, and 210 are the only independent claims rejected under § 103(a) based on the Office Action's proposed, hypothetical combination of Gueret and Vasas. Applicant respectfully traverses the § 103(a) rejection of each of those independent claims based on the hypothetical combination of Gueret and Vasas because the Office Action has failed to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, among other requirements, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2142. Furthermore, "[t]he teaching or suggestion to make the claimed combination . . .

must . . . be found in the prior art, not in applicant's disclosure." § 2143 (citation omitted). In other words, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Id. at § 2143.01 (citation omitted). Furthermore, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. § 2143.01 (citation omitted).

The Office Action fails to establish that Applicant's independent claims 1, 31, 61, 91, 120, 150, and 210 are *prima facie* obvious at least because there is no legally sufficient suggestion or motivation found in the prior art to modify the Gueret reference's disclosure in view of the Vasas reference's disclosure.

In the Office Action, the rejection statement asserts that "Gueret does not disclose the core being curved as claimed" Office Action at 5. The rejection statement nevertheless concludes, however, that "[i]t would have been obvious . . . to employ the curve[d] [sic] core as taught by Vasas for maximizing application and combining functions and matching the curve of an eyelid." Id.

Applicant respectfully disagrees with the rejection statement's unsupported obviousness conclusion at least because the Vasas reference does not provide any suggestion or motivation to make the rejection statement's proposed, hypothetical modification to the Gueret disclosure. In particular, there is no disclosure in either the Gueret reference or the Vasas reference that supports the rejection statement's unsupported obviousness conclusion. Furthermore, making the rejection statement's proposed, hypothetical modification might possibly result in altering the shape of the

envelope surface of the Gueret brushes, such that the Gueret brushes' intended make-up effects might possibly be altered. As a result, such a modification to the Gueret brushes might possibly result in changing their principle of operation.

For at least these reasons, there is no legally sufficient suggestion or motivation to make the rejection statement's proposed, hypothetical modification to Gueret's disclosure based on Vasas. As a result, the Office Action has failed to established a *prima facie* case of obviousness. Therefore, each of Applicant's independent claims 1, 31, 61, 91, 120, 150, and 210 is patentably distinguishable from the Office Action's proposed, hypothetical combination of the Gueret and Vasas references.

IV. Claim Rejection under § 103(a) based on Gueret in Combination with Kingsford

In the Office Action, claims 180, 182-186, 195-198, 200-204, and 205-209 were rejected under 35 U.S.C. § 103(a) based on Gueret in combination with Kingsford (U.S. Patent No. 5,137,038). Claim 180 is the only independent claim rejected based on the Office Action's proposed, hypothetical combination of Gueret and Kingsford. Applicant respectfully traverses the § 103(a) rejection of independent claim 180 based on that hypothetical combination because the Office Action has failed to establish a *prima facie* case of obviousness.

In the Office Action, the rejection statement asserts that Gueret does not disclose a "brush having a free end being not aligned with the axis of the end portion of the stem." Office Action at 6. The rejection statement nevertheless concludes, however, that "[i]t would have been obvious . . . to employ the particular brush as taught by

Kingsford into the brush of Gueret for the purpose of maximizing application and combing functions.” Id.

Applicant respectfully traverses the rejection statement’s unsupported obviousness conclusion at least because there is no suggestion or motivation to make the rejection statement’s proposed, hypothetical modification to the Gueret disclosure based on Kingsford. The Gueret reference discloses exemplary embodiments of a brush having a straight core that is aligned with an axis of an end portion of a stem. In contrast, the Kingsford reference discloses a mascara applicator having a brush which can be adjusted by a user from straight to curved. The brush includes a wand having an adjusting rod slidably disposed therein, which connects to a manipulating means within a handle of the applicator. The rod is extendable into an applicator head located on an end of the wand and the rod may be straight so as to straighten a precurved applicator or curved so as to impart curvature to a straight applicator.

There is no disclosure, however, in the Kingsford reference that would suggest making the rejection statement’s proposed, hypothetical modification to the Gueret reference’s disclosure. Furthermore, making the rejection statement’s proposed, hypothetical modification to Gueret’s brushes might possibly result in altering the shape of the envelope surface of the Gueret brushes, such that the Gueret brushes’ intended make-up effects might possibly be altered. As a result, such a modification to the Gueret brushes might possibly result in changing their principle of operation.

For at least these reasons, there is no legally sufficient suggestion or motivation to make the rejection statement’s proposed, hypothetical modification to Gueret’s disclosure based on Kingsford. As a result, the Office Action has failed to establish a

prima facie case of obviousness. Therefore, Applicant's independent claim 180 is patentably distinguishable from the Office Action's proposed, hypothetical combination of the Gueret and Kingsford references.

V. Claim Rejection under 35 U.S.C. § 103(a) based on Vasas

In the Office Action, claims 25, 55, and 234 were rejected under 35 U.S.C. § 103(a) based on Vasas. Claim 25, 55, and 234 ultimately depend from a corresponding one of independent claims 1, 31, and 210. Therefore, claims 25, 55, and 234 should be allowable for at least the same reasons their corresponding independent claim is allowable.

VI. Claim Rejection under § 103(a) based on Gueret in Combination with Kingsford and Vasas

In the Office Action, claim 194 was rejected under 35 U.S.C. § 103(a) based on Gueret in combination with Kingsford and Vasas. Claim 194 depends from independent claim 180. Therefore, claim 194 should be allowable for at least the same reasons independent claim 180 is allowable.

VII. Withdrawn Independent Claims 240 and 272

Independent claims 240 and 272 were withdrawn as being directed to a non-elected inventions. Applicant respectfully requests that those claims be rejoined and allowed.

A. Independent Claim 240

Independent claim 240 recites a method of manufacturing a brush, including, among other recitations, “providing a blank comprising a core, [and] a plurality of bristles . . . defining a cross-section of the blank . . . ; and curving the core along at least a portion of its length so that an axis of the core defines a curve in a plane of curvature, . . . wherein the blank is transformed into a brush and the cross-section of the brush at at least one position along the length of the core is substantially asymmetric in relation to a plane perpendicular to the plane of curvature.”

For reasons at least similar to those outlined previously herein with respect to independent claim 1, independent claim 240 should be allowable. Therefore, Applicant respectfully requests rejoinder and allowance of independent claim 240.

B. Independent Claim 272

Independent claim 272 recites a method of manufacturing a brush, including, among other recitations, “providing a blank comprising a core, [and] a plurality of bristles . . . defining a cross-section of the blank . . . ; and curving the core along at least a portion of its length so that an axis of the core defines a curve in a plane of curvature, . . . wherein the blank is transformed into a brush and the cross-section of the brush at at least one position along the length of the core is substantially asymmetric in relation to a plane perpendicular to the plane of curvature.”

For reasons at least similar to those outlined previously herein with respect to independent claim 1, independent claim 272 should be allowable. Therefore, Applicant respectfully requests rejoinder and allowance of independent claim 272.

VIII. Conclusion

As outlined above, independent claims 1, 31, 61, 91, 120, 150, 180, and 210 should be allowable. Dependent claims 3, 4, 6, 7, 15-19, 21-30, 33-37, 45-49, 51-60, 64-67, 75-79, 81-90, 93-96, 104-108, 110-119, 122-126, 134-138, 140-149, 152-156, 164-168, 170-179, 182-186, 194-198, 200-209, 212-216, 224-228, and 230-239 each depend from one of allowable independent claims 1, 31, 61, 91, 120, 150, 180, and 210. Therefore, each of those dependent claims should be allowable for the same reasons their corresponding independent claim is allowable, as well as by virtue of their recitations of additional novel and non-obvious subject matter. Furthermore, withdrawn claims 2, 5, 8-14, 20, 32, 38-44, 50, 62, 63, 68-74, 80, 92, 97-103, 109, 121, 127-133, 139, 151, 157-163, 169, 181, 187-193, 199, 211, 217-223, and 229 each depend from one of the allowable independent claims 1, 31, 61, 91, 120, 150, 180, and 210. Therefore, each of those claims should be rejoined and allowed.

In addition, independent claims 240 and 272 should be allowable, so those claims should be rejoined and allowed. Dependent claims 241-271 and 273-297 depend respectively from independent claims 240 and 272. Therefore, those dependent claims should be allowable for at least the same reasons independent claims 240 and 272 are allowable, and dependent claims 241-263, 265-271, 273-292, and 294-297 should be rejoined and allowed. (Dependent claims 264 and 293 have not been withdrawn, and those dependent claims should be allowable for at least the same reasons independent claims 240 and 272 are allowable.)

Applicant respectfully requests reconsideration of this application, withdrawal of the outstanding claim objections and rejections, and allowance of claims 1-297.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (571) 203-2739.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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